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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,683	11/15/2000	Steven Guttman	22233.05481	9013

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INTERNATIONAL BUSINESS MACHINES CORP
IP LAW
555 BAILEY AVENUE , J46/G4
SAN JOSE, CA 95141

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,683

Applicant(s)

GUTTMAN ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 25-27 is/are pending in the application. ¹⁻²⁷
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 21-24 is/are allowed.
- 6) ☒ Claim(s) 1-20 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/01, 4/04, 9/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Application History

1. This action is responsive to the applicant's filing of "*Amendment A and Response to Restriction Requirement*", filed on 6/29/2004.
2. In the response to the examiner's restriction requirement filed on 6/1/2004, the applicant has elected Group I (claims 1-20 and 25-27), for prosecution purposes, as recited in applicant's response of 6/29/2004.
3. Claims 1-20 and 25-27 are pending in the case, claims 1, 7, 10, 12, and 25 are independent claims.
4. Acknowledgement is made to the applicant's submission of two Preliminary Amendments, filed on 1/22/2001 and 5/21/2001.
5. Acknowledgement is made to the applicant's submission of three Information Disclosure Statements, filed 3/6/2001, 4/26/2004 and 9/7/2004.

Priority

6. Applicant's claim for domestic priority of US provisional application 60/241,083, filed 10/16/2000, under 35 U.S.C. 119(e) is acknowledged.

Drawings

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "1004" in Figure 10.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

8. The disclosure is objected to because of the following informalities:
- The disclosure recites "*A string of text entry, such as "Make Thanksgiving dinner" as displayed in cell A1 (104)*" (page 7, lines 1-2; page 10, line 17; page 19, lines 2-3; and page 21, lines 8-9). Reference sign 104 in Figure 1 is directed toward "*Make the Ultimate Holiday Dinner*".
 - The disclosure recites "*Side of Fruits and Vegetables, Side of Potatoes, Crab Cake and Cranberry Juice 406*" (page 11, lines 3-4). Reference sign 406 in Figure 4 fails to disclose "*Side of Fruits*" or "*Crab Cake, and Cranberry Juice*".

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- The disclosure fails to disclose those reference signs listed in paragraph 7 above, which are shown in the drawings.

Appropriate correction is required.

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

11. Claims 1-4, 10-11 and 12-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. **Regarding Claims 1-4, 10-11 and 12-20**, the method claimed in claims 1-4, 10-11 and 12-20 are not embodied on a computer readable medium. Methods not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). See MPEP § 2106 (IV.1.a)

Furthermore, the method claimed in claims 1-4, 10-11 and 12-20 are a non-descriptive data structure. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. See MPEP § 2106 (IV.1.b).

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. "

14. Claims 13, 14 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. **Regarding dependent claim 13**, the claim recites the limitation "*the cells depending on values in other cells*" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 13 is dependent upon claim 12. Claim 12 fails to mention the recited limitation.

16. **Regarding dependent claim 14**, the claim recites the limitation "*the cells with values that other cells depend on*" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 14 is dependent upon claim 12. Claim 12 fails to mention the recited limitation.

17. **Regarding dependent claims 18-20**, claim 18 recites the limitation "*in each Spreadsheet/Calculator Data file and Data Array file*" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 18 is dependent upon claim 12. Claim 12 fails to mention the recited limitation. Claims 19 and 20 are rejected for depending from defective claim 18.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

19. Claims 1, 5 and 10-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Chester et al., Mastering Excel 97, published in 1997 by SYBEX Inc. (hereinafter Chester).
20. **Regarding independent claim 1**, Chester discloses a spreadsheet as a calculator. Chester recites: *"Excel calculates worksheet formulas when changes to the cell values so require"* (page 113, second paragraph). Chester discloses a spreadsheet as a web page. Chester recites: *"you can create an HTML web page from the data and objects on a worksheet, and ultimately publish the page at a web site"* (page 961, right hand column, paragraph 8). Chester discloses requesting a spreadsheet web page by a user. Chester recites: *"To open a web document, choose FILE > OPEN and enter the HTTP address in the FILE NAME box"* (page 961, right hand column, last paragraph). Chester discloses displaying a spreadsheet, wherein only certain cells in the spreadsheet are editable. Chester recites: *"Sometimes you may want to protect individual cells in a worksheet. Select FORMAT > CELLS,*

then select the Protection tab (Figure 11.3)" (page 294, paragraph 1). Chester discloses a spreadsheet with both editable and non-editable cells. Chester recites; "The following options are available from the Protection tab in the Formats cells dialog box. Locked: Cells can't be changed after the sheet is protected. Hidden: hides formulas after sheet is protected" (page 294, second paragraph) and "By default, each cell is individually set with Locked checked – you must individually unlock each cell that users will be allowed to change before you protect the worksheet" (page 294, last paragraph).

21. **Regarding dependent claim 5**, Chester discloses displaying the calculator on a client machine. Chester recites: *"When you attempt to open a file that is in use by someone else on the network"* (page 35, second paragraph). Chester is describing a typical network with a plurality of users on client machines.
22. **Regarding independent claims 10, 12 and 25**, the claims contain substantially the same subject matter as claim 1, and are rejected using the same rationale.
23. **Regarding dependent claim 11**, Chester discloses previewing the calculator spreadsheet. Chester recites: *"Preview: Displays a preview of the selected file in the open dialog box"* (page 34, second paragraph).
24. **Regarding dependent claims 13-15**, Chester discloses spreadsheet cells that are non-editable, and editable as described above. Chester further

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discloses that cells may contain text. Chester recites: "*Text in a cell can include any combination of letters, numbers and keyboard symbols*" (page 58, third paragraph).

25. **Regarding dependent claim 16**, Chester discloses the ability to toggle the edit ability of a cell on and off as described above, in reference to claim 1.

26. **Regarding dependent claim 17**, Chester discloses spreadsheet cells with border, where the border can be blue in color. Chester recites: "*Border: provides a preview of cell borders and controls which borders are applied to selected cells*" (page 126, first paragraph) and "*Color controls the color of the selected borders*" (page 125, last paragraph).

27. **Regarding dependent claims 18-20**, Chester discloses the use of an edit ability flag (claim 18), where the flag can be set to false (claim 19) or true (claim 20). Chester discloses the use of an edit ability flag in Figure 11.3 on page 294. The figure further discloses the flag having a true value (shown as a check mark in the selector box) or set to false (the absence of a check mark in the selector box).

28. **Regarding dependent claim 26**, Chester discloses building an input box for editable cells. Chester recites: "*The following exercise will show you how to format a text box using some formatting techniques*" (page 331, paragraph 4).

29. **Regarding dependent claim 27**, the claim is rejected for fully incorporating the deficiencies of the base claims.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

30. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chester in view of Courter et al. Mastering Microsoft Office 2000 Professional Edition, published in 1999 by SYBEX Inc. (hereinafter Courter).

31. **Regarding dependent claim 2**, Chester discloses a spreadsheet as a calculator web page as described above. Chester fails to disclose e-mailing the calculator to a recipient. Courter teaches the e-mailing of Microsoft documents. Courter recites: *“Choose FILE > SEND TO > ROUTING RECIPIENT to display the Routing slip dialog box shown in Figure 12.9”* (page 282, paragraph 7) and see Figure 12.9 on page 183, which shows a dialog box where a user would enter a recipient's address.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the web calculator spreadsheet of Chester, with the e-mail capabilities as taught by Courter in order to *“make sharing and exchanging documents a snap”* (Courter, page 282, third paragraph).

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32. Claims 3-4, 6-9 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chester in view of Pollack et al. US Patent 6,493,733, filed 6/23/2000, patented 12/10/2002 (hereinafter Pollack).
33. **Regarding dependent claims 3 and 4**, Chester discloses a spreadsheet as a calculator web page as described above. Chester fails to disclose copying HTML code based upon an ID of requested information (claim 3) where the HTML includes Java Script tags (claim 4). Pollack teaches copying HTML code based upon requested information. Pollack recites: *"One method to help web site authors insert interactive HTML object into their web pages was to provide the HTML code for the interactive HTML object over the Internet"* (column 1, lines 56-58). Pollack further recites: *"manually cut and paste the HTML code into his web page"* (column 7, lines 59-60). Pollack teaches the use of Java Script tags. Pollack recites: *"the web site providing the interactive content includes some client-side script (such as JavaScript or VBScript)"* (column 3, lines 22-24).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the web calculator spreadsheet of Chester, with the HTML inserting method of Pollack in order to *"reduce the complexity inserting interactive HTML objects into files"* (Pollack, column 3, lines 54-55).

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34. **Regarding dependent claim 6**, the claim contains substantially the same subject matter as claims 3 and 4, combined and is rejected using the same rationale.
35. **Regarding independent claim 7**, the claim contains substantially the same subject matter as claims 1 and 3, combined and is rejected using the same rationale.
36. **Regarding dependent claims 8 and 9**, the claim contains substantially the same subject matter as claim 4 and 3, respectively, and are rejected using the same rationale.

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Conclusion

37. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-6,195,794	02-2001	Buxton, Jeffrey J.
• US-6,199,078	03-2001	Brittan et al.
• US-6,260,044	07-2001	Nagral et al.
• US-6,356,924	03-2002	Mullen-Schultz, Gary Lee
• US-6,438,545	08-2002	Beauregard et al.
• US-6,510,417	01-2003	Woods et al.
• US-6,510,461	01-2003	Nielsen, Jakob
• US-6,658,662	12-2003	Nielsen, Jakob
• US-6,687,734	02-2004	Sellink et al.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
February 7, 2005


STEPHEN HONG
SUPERVISORY PATENT EXAMINER